REMARKS

Claims 1 to 28 and 31 to 33 are pending, of which Claims 1, 11, 16 and 24 are independent. Claims 1, 11, 16, 18, 24, 28, 32 and 33 are amended. Reconsideration and further examination are respectfully requested.

By way of an introduction and a non-limiting example, one or more embodiments have application in an advertising industry that serves ads via a network to a user computer, and desires to monitor the effectiveness of served ads. Any of a number of measures might be used in monitoring an ad's effectiveness, including capturing the number of times the ad is viewed by a user (often referred to as a "page view"), the number of times a user activates a link in the ad to the advertiser's web page (often referred to as a "click-through"), and the number of times a user makes a purchase after activating a link in the ad (often referred to as an "acquisition").

In accordance with a conventional approach described in the present application, an "ad-serving entity" receives advertising content from advertisers or agencies, and uses a staff of programmers to incorporate received ad content into ad code before the ad content is served to a user computer. This process must be repeated any time the ad content and/or ad code changes. Such work is labor intensive and results in both decreased profits for the entities serving the ads and, to the extent the cost is not completely absorbed by the entity serving the ad, increased advertising costs to the advertiser and/or agency.

In accordance with aspects of the claims, by way of non-limiting example, an integrated ad file, which is served to a computer to provide the ad, is created by combining an ad input file, which identifies ad content, with a conduit file, which comprises computer code to track the ad. With this arrangement, an advertiser may provide the content to any number of different ad-serving entities without concerning itself with the ad tracking methodologies that are to be used with the content. Similarly, a tracking methodology can be selected and implemented independent of the ad content. On one hand, advertisers may modify the ad content without implicating changes to the tracking code, and on the other hand, modifications can be made to the tracking methodology and code without implicating changes to the ad content.

By way of a non-limiting example and with reference to Figure 5 of the present application, in accordance with one or more embodiments, an ad input file, e.g., ad input file

504, is combined with a conduit file, e.g., conduit file 506, using a merge tool 502 to automatically create an integrated ad file prior to serving the integrated ad file from a computer. The merge tool 502 automatically creates integrated ad file 204 using the ad input file 504 and the conduit file 506, wherein the ad input file 204 identifies the content of the ad and the conduit file comprises computer code to identify tracking data for the ad. Reference is also respectfully made to Figures 6 to 9 of the present application. Figure 6 illustrates a portion of an exemplary ad input file 502, and Figure 8 provides an example of an integrated ad file 204 portion that includes the contents of the exemplary ad input file 502. As is described in paragraph [0028] of the published application, the ad input file includes the contents of the ad. Figure 7 illustrates a portion of an exemplary conduit file 506, and Figure 9 illustrates a portion of the integrated ad file 204 portion that includes the exemplary conduit file 506.

Claims 1, 4, 7 to 12, 16, 18 to 21, 24 to 26 and 31 to 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by a document identified by the URL: http://demo.doubleclick.com/ generators /docs/ designer-version.pdf URL, which is referred to as "DoubleClick", and Claims 2, 3, 5, 6, 13, 15, 17, 22, 23, 27 and 28 are rejected under 35 U.S.C. § 103(a) over DoubleClick in view of Official Notice. Reconsideration and withdrawal of the rejections are respectfully requested for at least the reasons set forth below.

With respect to Claims 2, 3, 5, 6, 13, 15, 17, 22, 23, 27 and 28, the Office Action takes Official Notice in rejecting these claims. The Applicant requests that the Examiner provide the requisite support for the Officially Noticed facts, should the Examiner continue to rely on Official Notice. In *In Re Chevenard*, 139 F.2d at 711, 60 USPQ at 239 (CCPA 1943), which is cited in the MPEP, something more than a total absence of some demand is sufficient, and that such a response would be more than sufficient to prompt the examiner to produce authority for her assertions in response. It is clear from MPEP § 2144.03 and the case law provided therein that Applicant's request/response is more than sufficient to establish that such support is required and that such support should be supplied, as requested by the Applicant. Furthermore and as is also made clear in MPEP § 2144.03, Official Notice is only appropriate in a limited number of circumstances and should only be taken where the facts asserted to be well-known or common knowledge are capable of instant and unquestionable demonstration as being well-known or common knowledge, which is not the case here.

Therefore, with respect to the Official Notice taken, the Applicant respectfully requests that the Examiner provide evidence that supports the Officially Noticed facts, should the Examiner maintain the current rejection. Furthermore, it is respectfully submitted that the Officially Noticed facts fail to cure the deficiencies noted herein with respect to DoubleClick.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file that identifies the content of an ad is combined, at a server, with a conduit file that is separate from the ad input file and that comprises computer code to identify tracking data for the ad, the combining of the ad input file and separate conduit file uses a merge tool that automatically creates a single integrated ad file from the ad input file and separate conduit file prior to serving the single integrated ad file from a server. The single integrated ad file has a single file extension, contains both the ad input file and the conduit file and is served from the server to provide the ad.

In rejecting Claim 1, the Office Action states, at page 2, that (italics in original):

"[r]egarding claim 1, DoubleClick teach *combining at a server* an ad input file (Flash file, FLASH banner ads, FLASH movie) with a conduit file (click tracking string, ClickTag) to automatically create a single integrated ad file having a single file extension (swf file) *containing both the ad input file and the conduit file* (ActionScript used to combine the clicktag together with the movie); *wherein the conduit file comprises of computer code* (ClickTag) *for tracking data for the ad,* and serving the integrated ad file from a computer to provide the ad (see pp 1-3)."

DoubleClick describes the details for a person to edit an ad Flash file to create an ad Flash file that is compliant with DoubleClick's DART system. According to the instructions provided in DoubleClick, a person, referred to as a designer in DoubleClick, must edit the ad Flash file to include a "clickTag" variable, and select a setting to indicate to the ActionScript that the variable is to be evaluated as an expression. At page 1, DoubleClick describes that its tracking method provided by the DART system uses the "clickTag" variable to pass a click tracking string into the Flash movie. Once the person makes the edits to the ad Flash file to create an ad Flash file that is compliant with the DART system, the destination URL and click tracking string can be changed at the DART system without changing the ad Flash file (see page 1, DoubleClick). DoubleClick mentions only the clickTag variable as being a part of the ad

Flash file, which variable must be added to the ad Flash file by a person editing the ad Flash file;

DoubleClick does not disclose computer code to identify tracking data for an ad, which is

contained in a conduit file that is combined with an ad input file by a merge tool that

automatically creates a single integrated ad file containing the contents of the conduit file (the

computer code to identify tracking data for the ad) and the contents of an ad input file (the

content of the ad), as recited in Claim 1. At page 2, DoubleClick describes that Figures 1 and 2

show examples of what the Flash 4 or Flash 5 interface should look like after the person that is

designing the ad Flash file sets all the parameters in compliance with DoubleClick's instructions.

Referring to Figure 1 of DoubleClick, for example, the designer must input the variable

"clickTag" in a URL box, ensure that the button to the right of the URL box is set to "=" to

indicate that the ActionScript is to evaluate "clickTag" as an "expression" and type "_blank" in

the window box. This click tag is not a conduit file that is merged with the ad file, it is a needed

modification to the ad file itself, made by the ad's creator. As a result of the edits made by the

designer to the ad Flash file, <u>after the ad Flash file is served to the user computer and at the time</u>

<u>that the ad Flash file's movie is played at the user computer, ActionScript evaluates the</u>

<u>"clickTag" expression and replaces it with the tracking string and the destination URL from</u>

<u>HTML code in DoubleClick's DART system</u>. As is described at page 3 of DoubleClick:

> The text that is entered into the URL box is an expression. When the movie
> plays, the expression will be evaluated and replaced with the click tracking string
> and the destination URL from the HTML sniffer code, in the DART system. In
> order for this method to function correctly, you must indicate that the text is an
> expression. In Flash 4, the button to the right of the URL should have an equal
> sign. It should not have the letters abc. (See Fig. 1.) In Flash 5, the expression
> check box should be checked. (See Fig. 2). Note that there are two buttons or
> check boxes. One is for the URL and one is for the target window. Make sure
> that the button or check box for the URL is set correctly

DoubleClick mentions only an ad Flash file. In contrast, the claim language recites both

an ad input file and a conduit file that is separate from the ad input file. DoubleClick describes

that a designer must modify the ad Flash file to add the "clickTag" expression to make it

compliant with Doubleclick; and DoubleClick describes that, when the movie from the

11

designer-edited ad Flash file plays, ActionScript evaluates the Flash file's "clickTag" expression and replaces the "clickTag" expression with the click tracking string and the destination URL from HTML sniffer code in DoubleClick's DART system. In contrast, the claimed combining is performed prior to the server serving the integrated ad file, and the claimed combining combines two separate files, the claimed ad input and conduit files, using a merge tool that automatically creates the claimed single integrated ad file from the two separate files.

The DoubleClick approach is much like the approach described in the background discussion of the present application, i.e., a labor intensive process whereby someone must edit the ad file to include the "clickTag" variable in DoubleClick's case. DoubleClick, therefore, suffers from many of the same drawbacks discussed in the background discussion of the present application, i.e., each time the ad is modified, the ad Flash file must be updated; e.g., DoubleClick discloses that a person must edit an ad Flash file any time the DART system requires the ad Flash file to be changed to make it compliant with the DART system. This is precisely the shortcoming avoided by the present claims. By way of a non-limiting example, the claimed merge tool that automatically creates an integrated ad file from an ad input file and a conduit file avoids the need for a designer to makes the edits to an ad Flash file described in DoubleClick.

DoubleClick does not disclose or suggest the claimed ad input file that identifies the content of an ad and a conduit file that is separate from the ad input file and that comprises computer code to identify tracking data for the ad, combining the ad input file and the separate conduit file using a merge tool that automatically creates a single integrated ad file from the ad input file and the separate conduit file. Additionally, DoubleClick fails to disclose or suggest combining two separate files, an ad input file and a conduit file, to create a single integrated ad file prior to the server serving the single integrated ad file. DoubleClick fails to disclose or suggest an ad input file that identifies content of an ad and a conduit file which is separate from the ad input file and comprises computer code to identify tracking data for the ad; DoubleClick further fails to disclose the claimed combining of the ad input file and the separate conduit file using a merge tool to automatically create a single integrated ad file from the ad input file contents and the conduit file, the claimed single integrated ad file being automatically created prior to a server serving the single integrated ad file and has a single file extension.

With regard to independent Claims 11, 16 and 24 and dependent Claims 13-15, 17, 22, 23, 27 and 28, the Office Action fails to identify what the Examiner considers corresponds to the claimed placeholder or the claimed first and second placeholders. The Applicant renews their request for the Examiner to provide a clear indication of the specific element described in DoubleClick that the Examiner considers corresponds to the claimed placeholder and the claimed first and second placeholders, should the Examiner maintain the current rejection. It is respectfully submitted that DoubleClick fails to disclose the claimed placeholder and the claimed first and second placeholders. In addition to the deficiencies noted above, it is respectfully submitted that DoubleClick fails to disclose these further elements of Claims 11, 16 and 24 and dependent Claims 13-15, 17, 22, 23, 27 and 28.

For at least the foregoing reasons, independent Claims 1, 11, 16 and 24, and the claims that depend from these claims, are believed to be patentable over DoubleClick.

With respect to Claims 7 to 10, the Office Action alleges that page 3 of DoubleClick teaches an ad input file specifying one or more button actions, each of which has an exit code (Claim 7); a conduit file (Claim 8), or JavaScript file (Claim 9), which includes code that determines whether an ad opens in a parent window or a new window using a variable included in HTML code used to serve the single integrated ad file; and tracking an ad using code in the claimed conduit file and a tracking identifier included in HTML code serving the claimed single integrated ad file (Claim 10). In view of the above discussion of DoubleClick, including page 3 of DoubleClick, it is respectfully submitted that DoubleClick fails to disclose or suggest at least the above-identified elements of Claims 7 to 10. Should the Examiner maintain the § 102 rejection of Claims 7 to 10 over DoubleClick, the Examiner is respectfully requested to identify the particular portions and precise elements of DoubleClick that the Examiner considers teaches each and every one of the elements recited in Claims 7 to 10.

Furthermore and with respect to Claim 2, a modified single integrated ad file having a single file extension is created by combining, at a server, a received modified ad input file representing a change to the content of an ad with the conduit file. Claim 3 recites steps of receiving, at a server, a modified conduit file representing a change to the tracking data, combining, at a server, the modified conduit file with the ad input file to create a modified single integrated ad file having a single file extension, and serving the modified single integrated ad file

from the server, to provide an ad having the changed tracking data. DoubleClick provides the designer with instructions for making the edits to an ad Flash file to make the ad Flash file compliant with the DART system. The instructions require that the ad Flash file be edited to include a "clickTag" variable with appropriate settings. Based on the description provided in DoubleClick, the ad Flash file that includes "clickTag" would need to be revised by the designer to make a change to the "clickTag" variable and/or its settings, for example. Additionally and according to DoubleClick, a new ad Flash file would need to be edited by a designer to add the "clickTag" variable and settings per the instructions provided in DoubleClick. DoubleClick does not disclose or suggest combining a modified ad input file with a conduit file to create a modified single integrated ad file. Further, DoubleClick does not teach or suggest combining a modified conduit file with an ad input file to create a modified single integrated ad file. As a result, dependent Claims 2 and 3 are allowable over DoubleClick.

Referring to Claim 5, the ad input file includes an empty movie clip object such that the combining of an ad input file with a conduit file to create a single integrated ad file recited in Claim 1 includes inserting the conduit file into the empty movie clip object. Claim 6 depends from Claim 5, and further recites that the empty movie clip object is given a predefined name and combining the ad input file and conduit file includes searching the ad input file for the predefined name and inserting the conduit file into the empty movie clip with the predefined name. In view of the complete absence of any teaching or suggestion in DoubleClick with respect to multiple elements of Claims 5 and 6, as conceded in the Office Action, the Applicant traverses the Official Notice taken in the Office Action. Should the Examiner maintain the rejection, the Applicant respectfully requests that the Examiner provide evidentiary support for the "Officially Noticed" facts, and requests that the Examiner provide documentary evidence with respect to the claimed empty movie clip object of the ad input file into which the claimed conduit file is inserted, combining an ad input file and a conduit file by inserting the conduit file into the empty movie clip of the ad input file, searching the ad input file for a predefined name of the empty movie clip of the ad input file, and combining an ad input file to create an integrated ad file by inserting the conduit file into the empty movie clip having the predefined name in the ad input file.

Since DoubleClick is missing at least one, and in many cases more than one, element of the claims, DoubleClick cannot properly be used as the basis for a § 102 rejection. Furthermore, and since DoubleClick is missing at least one element which is also not one of the Officially Noticed facts, DoubleClick in view of the Official Notice taken cannot form the basis of a proper § 103(a) rejection of the claims.
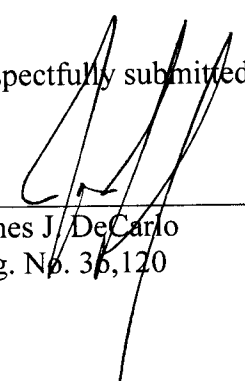
In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The Applicant's attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address that is associated with Customer Number 76058.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

Date: January 19, 2010

James J. DeCarlo
Reg. No. 36,120

Customer Number 76058
GREENBERG TRAURIG, LLP
Met Life Building
200 Park Avenue, 34th Floor
New York, New York 10166
Phone: (212) 801-6729
Fax: (212) 801-6400

NY240,023,9081